

informalities in the disclosure and in the claims. In response, Applicant has canceled duplicate claims 1-7. Applicant has accordingly amended the disclosure to insert the appropriate temperature related symbols. Claims 2-4, 6-8, 11-13 and 15-16 have been amended to insert the degree symbol and to remove the inconsistency between the degree in Fahrenheit and the degree in centigrade. Therefore, the Applicant requests that the Examiner reconsider and withdraw the objections.

#### Claim Amendments

Claims 1-16 were amended. New claims 17-24 have been added.

#### Claim Rejections Under 35 U.S.C. § 112

Claims 1-5 and 9-16 were rejected under 35 U.S.C. § 112, first paragraph, as based on a disclosure which is not enabling. The detailed action expresses the following as the basis for said rejection.

The following formulation comprising greater than 95 percent aliphatic hydrocarbons comprises a mixture (a) between 13-23 weight percent 95 percent aliphatic petroleum naphtha; (b) between 17 and 25 percent aliphatic petroleum distillates; and (c) between 5 and 10 percent base oil, wherein said mixture having a boiling point between 390 and 410° F a specific gravity between 0.7 and 0.75, and water insolubility, and a method for the preservation of a film print comprising said formulation is critical or essential to the practice of the invention but not included in the claim(s) is not enable by the disclosure. . . . The disclosure set forth on page 3, lines 9-22 indicate that said features were considered by Applicants, are not set forth in the instant claims.

Applicant submits that the specification does not expressly state that "said formulation is critical or essential to the practice of the invention." Rather, Applicant clearly states that "one preferred formulation comprises" the recited aliphatic hydrocarbon mixture and composition. Applicant merely discloses that "[t]he formulation is an organic mixture comprising greater than 95 percent aliphatic hydrocarbons" as set forth in the disclosure on page 3, lines 9 and 10. Accordingly, claims 1-5 and 9-16 are fully enabled by Applicant's disclosure at page 3, lines 9-16. Therefore, Applicant requests that the Examiner reconsider and withdraw the rejection.

Claims 1-16 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which Applicant

regards as the invention. Independent claims 1, 9 and 14 have been amended to include the limitation that the formulation is an organic mixture comprising greater than 95 percent aliphatic hydrocarbons. For the reasons noted above, the exclusion of the relative proportions of aliphatic petroleum naphtha, aliphatic petroleum distillates, and petroleum base oil does not render independent claims 1, 9 or 14 indefinite in that the claims as amended are fully supported by the specification at page 3, lines 9-10. The inconsistencies between the degree in Fahrenheit and the degree in centigrade have been corrected in the claim amendments. Therefore the Applicant requests that the Examiner reconsider and withdraw the rejection.

Claims 10-13 and 1-4 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite in that the latter claims are duplicated by claims 10-13. Applicant submits that the claims as amended are not indefinite. Therefore the Applicant requests that the Examiner reconsider and withdraw the rejection.

#### Claim Rejections Under 35 U.S.C. § 103

Claims 1-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nair *et al.* (Nair) 5,786,134; in view of Nicholas *et al.* (Nicholas) 5,462,459; Stowell 5,443,604; Booser's Handbook of Lubrication and Schey's Tribiology in Metal-working "Friction, Lubrication and Wear".

Nair teaches the manufacture of a motion picture print film having a support and having antihalation undercoat, silver halide emulsion, antistatic, and protective overcoat layers. The term "layer" is defined as a single thickness, coating or a stratum spread out or covering a surface. *See the American Heritage Dictionary, Second Edition (1982).* Nair discloses that the motion picture print film has solid and distinct layers of coatings laminated one onto the other. *See Nair, col. 1, lines 66-67, col. 2, lines 1-9.* In contrast, Applicant does not claim a motion picture print film comprising laminated layers. Nair further discloses that paraffins may be used as a suitable lubricating agent "to give the topcoat [layer] a coefficient of friction that ensures good transport characteristics *during manufacturing and customer handling of the photographic film.*" [Emphasis added.] *See Nair, col. 8, lines 45-51.* Notably, Nair teaches that the lubricating agent is preferably an aqueous dispersed lubricant that can be incorporated directly into the solid protective topcoat layer so as to avoid a "separately applied lubricant overcoat on the protective topcoat layer." *See Nair, col. 8, lines 66-67 and col. 9, lines 1-3.* Thus, the lubricating agent is not only a component of the solid laminated topcoat layer, but is not in contact with the film. It is clear that the lubricating

agent of Nair cannot be for the purpose of lubricating the film. In fact, Nair discloses that the lubricating agent is for the purpose of minimizing the coefficient of friction for "transport" e.g. through projection equipment, and for film stability during shipping and storage. See Nair, Col. 8, lines 45-65. Therefore, not only does Nair not disclose a coating applied to the exterior surface of a film, more importantly Nair teaches away from a coating which is not in contact with the film and which cannot be for the purpose of directly lubricating the film. Furthermore, as admitted by the Examiner, Nair does not teach the composition of the paraffin. Absent a teaching or suggestion by Nair that the paraffin could be used as a "film lubricant" and that it is in direct contact with the film, the combination of Nair with other references such as Nicholas, Stowell, Boozer and Schey which neither teach or suggest Applicant's claimed invention is an improper basis for rejection under 35 U.S.C. § 103(a). Therefore, the Applicant requests that the Examiner reconsider and withdraw the rejection.

Finally, the Examiner states that "[i]t would be obvious to the artisan in the art to select a mixture of aliphatic hydrocarbons of the secondary references as the paraffin lubricant and carriers preservative formulation for the topcoat composition of Nair for print film preservation because the solvent mixture is a conventional combination for preservative formulation." For the reasons noted above, Applicant traverses the Examiner's rejection under 35 U.S.C. 103(a) based on the assertion that one skilled in the art of the preservation of a film would look to the wood preservation compositions taught by Nicholas and the plastic surface polishing compound teachings of Stowell in light of the state of the art disclosed in Boozer and Schey and as such renders the claimed formulations and method for the preservation of film as claimed by Applicant obvious. Therefore, pursuant to MPEP 2144.03, Applicant submits that the claimed invention is not "well-known" nor can the cited references "fill the gaps," and requests that the Examiner provide an affidavit including the facts within her personal knowledge, the specific data relied on, and supporting documentation to support the rejections under 35 U.S.C. § 103(a).

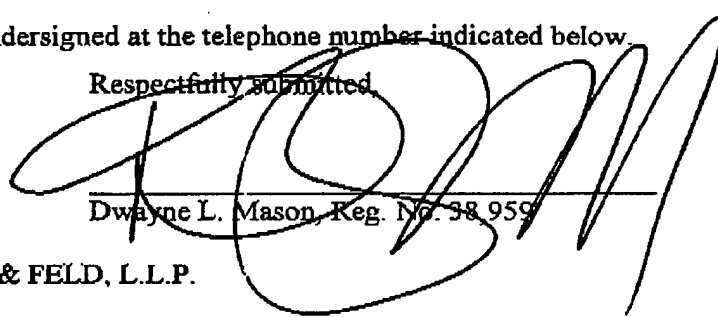
### CONCLUSION

The prior art made of record, but not specifically cited, is not believed to disclose any significant information that is not sufficiently discussed in this Amendment. It is respectfully submitted that all issues and rejections have been adequately addressed and that all claims as amended and pending following entry of this Amendment are now allowable and that the case should be advanced to issuance.

If the Examiner has any questions or wishes to discuss the claims as amended, the

Examiner is encouraged to call the undersigned at the telephone number indicated below.

Respectfully submitted,



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